

II. Provisional Obvious Double Patenting

The Office has provisionally rejected claims 1-30 under the judicially created doctrine of double patenting over claims 39 and 52 of co-pending Application No. 09/770,472. (Office Action, pages 2-3.) Although Applicants disagree with the rejection, they nevertheless enclose a terminal disclaimer, thereby obviating the rejection. Accordingly, Applicants request withdrawal of the rejection.

III. The Claims Are Not Indefinite Under 35 U.S.C. § 112, Second Paragraph

Claims 1-30 have been rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite. (Office Action, page 3.) Applicants traverse the rejection and submit that all claims are not indefinite or vague.

X [Regarding claim 1, the Office alleges that the phrase "disorders associated with seborrhea, and disorders associated with microorganisms of the genus *Propionibacterium*" is vague because the metes and bounds of "associated with" are unclear. Applicants submit that the phrase "associated with" is a well known term which would be readily understood by one of ordinary skill in the art, as evidenced by U.S. Patent 4,147,782 (*Klein*), relied upon by the Office for the prior art rejections. (See *Klein*, column 1, lines 5-9). Additionally, examples of disorders associated with seborrhea and *Propionibacterium* are provided in the specification, and may be relied upon to clarify the meaning of the phrase "associated with." See specification, page 1, paragraph 3 and page 3, paragraph 1.

Regarding claims 1, 4, 5, 10, 12, 13, 16, 17, and 21-24, the Office alleges that the phrase "hydrocarbon-based radicals" is vague because it is unclear whether such

radicals are limited to hydrocarbons only or if they may be substituted with other components. Applicants submit that the specification and claims make it clear that the "hydrocarbon-based" radicals may comprise components other than hydrogen and carbon. See, e.g., claim 4, which claims substituted hydrocarbon-based radicals and claim 5, which recites hydrocarbon-based radicals interrupted with at least one heteroatom. One of ordinary skill in the art would therefore understand that the phrase "hydrocarbon-based radical", as used in the present application, means that the radical may comprise other atoms in addition to hydrogen and carbon.

Applicants respectfully request reconsideration and withdrawal of the rejection.

IV. The Claims Are Not Anticipated Under 35 U.S.C. § 102(b)

The Office has rejected claims 1-3, 6-9, and 25-30 under 35 USC§ 102(b) as being anticipated by *Klein et al.*, U.S. Patent No. 4,147,782 ("*Klein*"), for the reasons set forth on page 4 of the Office Action. Applicants traverse the rejection because *Klein* does not teach all the limitations of the instant claims.

The Office asserts that *Klein* anticipates the instant claims because *Klein* allegedly teaches pharmaceutical preparations for treatment of skin ailments that contain "N-acyl esters of sarcosine (see col. 4, lines 46-62.)" (Office Action, page 4.) In order for a cited reference to anticipate a claimed invention, the reference must teach all of the limitations of the claims in question.

Applicants submit that *Klein* does not anticipate the claimed invention because each claim of the present invention requires that "at least one compound chosen from polyaminoacid derivatives of formula (I) and salts thereof" wherein n is greater than 1.

The sarcosine esters of Klein do not comprise a polymeric group, and do not read on the claimed polyamino acids, for which that value of "n" must be greater than 1. Therefore, Klein does not anticipate the claims of the present application.

Applicants respectfully request reconsideration and withdrawal of the rejection.

V. The Claims Are Not Obvious Under 35 U.S.C. § 103

The Office has rejected claims 1-30 under 35 U.S.C. § 103, as being unpatentable over *Morelle et al.*, U.S. Patent No. 4,089,954 ("*Morelle*"), in view of *Marx et al.*, U.S. Patent No. 5,898,037 ("*Marx*"), as asserted at page 5 of the Office Action. Applicants respectfully traverse this rejection.

To establish a prima facie case of obviousness, the Office must demonstrate that the prior art references teach or suggest all the claim limitations. In the present case, the Office has failed to make a prima facie case of obviousness because it has not met at least the above criteria.

Applicants submit that neither *Morelle* nor *Marx* teach the claimed polyamino acid derivative of formula (I) or salt thereof. Instead, *Morelle* teaches compositions of matter described by the formula at column 1, lines 35-43. Specifically, these compositions of matter comprise metal salts of amino acid ions. For example, see *Morelle*'s aluminum salt of example No. 1 at col. 2, line 60, comprising two caprylylglycinate ions that balance the +2 charge of the aluminum hydroxide, and also note the CH₃- terminal group at the end of the caprylylglycinate ion, indicating this is not a dimer. Thus, the compound of *Morelle* does not anticipate or even remotely suggest the claimed polyamino acid derivatives of present formula (I), which necessarily requires amino acid repeating units.

Certain examples in *Morelle* might be considered to comprise repeating units, such as example No. 3 (column 3, lines 5-12) and No. 11 (column 4, lines 3-10). However, the caprylylcystinates of these examples contain two sulfur atoms bonded together and, for at least this reason, clearly fall outside of the scope of the claimed polyamino acid derivatives of formula (I). The only other mention of any polyamino acid is the discussion of the lipopolyaminoacids of the prior art. See column 1, lines 24-30. Thus, *Morelle* does not teach or suggest the polyamino acid compounds of the presently claimed formula (I).

The Office relies on the *Marx* reference to supply the missing teachings of *Morelle*. According to the Office, *Marx* teaches the use of magnesium in topical formulations for treating conditions such as acne. (Office Action, page 5.) However, *Marx* also fails to teach or suggest the presently claimed compound of formula (I). Because neither *Morelle* nor *Marx* teach the claimed polyamino acid derivative of formula (I), no prima facie case of obviousness has been or can be established.

Accordingly, Applicants respectfully request that the Office reconsider and withdraw the rejection.

CONCLUSION

In view of the foregoing remarks, Applicants respectfully request reconsideration of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this Amendment and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

**FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.**

By: 

Charles D. Niebylski
Reg. No. 46,116

Dated: July 23, 2002

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com